REMARKS

Claims 1-20 are all the claims pending in the application.

Claim Rejections - 35 U.S.C. § 102(b) - Fernandez (1998)

The Examiner rejected claims 1-3, 5-7 and 20 under § 102(b) as being anticipated by

Fernandez (1998). Applicants traverse this rejection as follows.

In the Response to Arguments section, the Examiner provides:

> [B]ecause the cited disclosure is directed to different components
> wherein each independent program applications running under windows.
> Applicant's argument is not persuasive because Applicant argument fully
> supports that Fernandez anticipates the new limitation of "the media file
> management unit is implemented **in a single program** application." It is
> noted that Fernandez discloses a plurality of programs **running in a**
> **single Windows** application which reasonably anticipates the new
> limitation.

(*Office Action*, p. 5).

In response, Applicants respectfully submit that the Examiner's rejection is invalid for

the following reasons:

(1) The Examiner is impermissibly combining different embodiments of Fernandez;

(2) Fernandez fails to disclose (and it is not inherent) that each of the individual programs

discussed in Fernandez are executed at the same time; and

(3) Even if Fernandez could be construed to disclose that each of the applications are

executed at the same time, Fernandez fails to support that these are implemented in a single

program application.

Impermissibly Combining Embodiments

First, Applicants submit, consistent with the remarks set forth in the June 2, 2006 and

November 21, 2006, Amendments, that the Examiner is attempting to combine the features of

three independent programs (different embodiments) that run in the Windows environment to improperly reject these claims under § 102. However, it is well settled that different embodiments may not be combined absent a suggestion to do so. *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (BPAI 2003); *In re Arkley*, 455 F.2d 586, 587-588, 172 USPQ 524, 526 (CCPA 1972). Because no suggestion for combining these different software components exists within this or any other reference provided by the Examiner, the rejection by the Examiner is invalid. Additionally, the Examiner has failed to provide any suggestion to combine these embodiments.

In particular, it is well settled "that anticipation is <u>not</u> established if in reading a claim on something disclosed in a reference it is necessary to pick, choose, and combine various portions of the disclosure not directly related to each other by the teachings of the reference." (See *Ex parte Beuther*, 71 USPQ at 1316 citing *In re Arkley*, 172 USPQ 524, 526 (CPA 1972)). The Examiner attempts to brush off the importance of this case by merely stating that this case and the instant application have different fact patterns. Applicants respectfully disagree.

Specifically, in *Beuther*, the issue is the specific properties associated with a single product, i.e. "tissue." (*Beuther*, 172 USPQ at 1315). Moreover, the specific tissue is relegated to only embodiments of "layered tissue paper having a velutinous surface subjectively discernable by humans as being extremely soft and smooth, and to tissue paper products comprising one or more plies of such paper." (*Id.*). The reference applied by the Examiner in *Buether* discloses several embodiments of tissue meeting this narrow criteria yet the Federal Circuit held that the various embodiments were not directly related even though they were all in this narrow class of tissue that appear to be closely related. (*See id.*).

In contrast to this strict standard for determining whether various embodiments are directly related, the Examiner merely concludes that because the applications are capable of functioning under a single operating system, one of skill in the art would have understood that the applications are directly related. (Office Action, p. 7). Applicants submit that the Examiner's position is unsupported and, further, contradicts the standard for determining whether embodiments are directly related as set forth in *Beuther*. As evidenced by the above fact pattern, the criteria for determining whether two products in such narrow field are directly related is extremely strict in application.

Not Inherent That Applications Run Simultaneously

Moreover, no portion of Fernandez discloses that each of these applications is even run at the same time. Furthermore, that these are run at the same time is not an inherent feature within Fernandez. If a structure in a cited reference does not expressly disclose a claimed feature, but absolutely must include that claimed feature in order to function properly, then that feature is deemed to be inherently disclosed. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) ("[W]e are not persuaded that the "effect" of the processes disclosed in Smith and Sumitomo, an "effect" undisclosed in those patents, would be always to inherently produce or be seen always to produce products meeting all of the claim limitations.") In other words, if there are two or more possibilities with respect to the non-disclosed feature, then the non-disclosed feature is not inherent.

Here, because the different applications disclosed in Fernandez do not need to be executed at the same time to function properly and it is possible that they are not operated at the same time; it is not an inherent feature that they are executed simultaneously.

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Fernandez Fails To Disclose All Recited Features

Claim 1 recites, *inter alia*, "wherein the media file unit is implemented in a single program application."

As indicated above, the Examiner contends "that Fernandez discloses a plurality of programs **running in a single Windows** application." However, Applicants submit that Fernandez clearly fails to do so. Each of the different applications applied by the Examiner, e.g. Jet-Audio shareware (p. 32-34) and Cool Edit 96 for Windows, are each separate and distinct Windows applications; not a single Windows application. Furthermore, the Examiner seems to imply that the Windows Operating System is an application. However, there is a distinct difference between an operating system and an application operating under that operating system. Therefore, the Examiner's interpretation of the Window Operating System as an application is incorrect.

Even if the Examiner's improper interpretation is assumed to be true, and the Windows Operating Systems could be considered to be an application, Fernandez clearly discloses that three different applications would be running; Windows, Jet-Audio and Cool Edit 96. This simply does not correspond to the recitation of claim 1 - "wherein the media file management unit is implemented in a single program application."

Accordingly, because Fernandez fails to disclose wherein the media file unit is implemented in a single program application, Applicants submit that the applied reference fails to anticipate each and every element recited in claim 1. Additionally, because claim 20 recites features similar to those argued above with regard to claim 1, Applicants submit that claim 20 is

allowable for the same reasons set forth above. Finally, Applicants submit that claims 2-3 and 5-

7 are allowable, at least because of their dependency.

Claim Rejections - 35 U.S.C. § 102(a) - Rodriguez et al.

The Examiner rejected claims 1-6, 8-10, 12-16 and 18 as being anticipated by Rodriguez

et al. (2003/0005454; Rodriguez). Applicants traverse this rejection as follows.

Claim 1 recites, *inter alia*, "a media file management unit that creates . . . an edit window

that displays a media content file to be edited;" and

"a display driving unit that displays the search window and the edit window together in a

single display screen."

First, Applicants note that the Examiner has failed to respond to the arguments set forth

in the Amendment Under 37 C.F.R 1.114(c) filed December 22, 2006.

In the Advisory Action of December 6, 2006, the Examiner states:

> [T]he limitation of "edit" has been attributed with the customary
> and ordinary meaning of "to modify or add to data or text." Therefore,
> the disclosure of Rodriguez cited in the previous Office Action
> reasonably supports that the claimed invention is anticipated by said
> cited prior art. For example, Applicants pointed to Figure 14 in
> Rodriquez [which] describes a "search screen" wherein said search
> screen comprises a window 1424 that enables the user to enter
> alphanumeric characters . . . name of title, or any of the PRM
> information and the result display . . . will display the information.

(*Advisory Action*, p. 2).

Thus, the Examiner is now reading the Search window 1424 of Rodriguez to be both a

search window and an edit window. In contrast to the Examiner's interpretation of "edit",

Applicants submit this is not the customary and ordinary meaning of the term "edit window." In

fact, Rodriguez implies a different meaning, i.e. an edit screen 1200 which enables a user to enter

and/or edit certain personal annotations such as the media content category, date recorded, etc.

Accordingly, interpreting the mere inputting of text into a search window does not even comply

with the meaning of an edit screen as disclosed by the reference applied by the Examiner.

Moreover, the first initial inputting of text is not customarily referred to as an edit. Only after

text has been inputted and, then, subsequently modified, has the text been edited. Furthermore,

no portion of Rodriguez indicates that any data typed into the search window 1424 is ever used

to modify or add to any text or data. Therefore, Applicants submit that the search window 1424

does not correspond to an edit window.

Furthermore, assuming, *arguendo*, that the search window 1424 could be construed as an

edit window, Rodriguez fails to disclose that this edit window "displays a media content file to

be edited," as recited in claim 1. Specifically, Rodriquez discloses that this search window 1424

enables a user to enter alphanumeric characters to search for media content or other information.

Moreover, this text entry window only displays what is entered by a user. Accordingly, while

Rodriquez may disclose a text edit window in the same window as a search window, this text

edit window fails to correspond to the recited "edit window that displays a media content file to

be edited." Therefore, Rodriquez fails to anticipate every feature recited in claim 1.

Finally, on page 10 of the present Office Action, the Examiner states "Rodriguez does not

explicitly describe the limitation of a 'display driving unit that displays the search window and

the edit window together in a single display screen." This further supports the Applicants'

position.

Thus, Applicants submit that claim 1 is allowable for at least the reasons set forth above.

Additionally, Applicants submit that claims 2-6 and 8-10 are allowable, at least because of their

dependency. Because claim 12 recites features similar to those set forth above with regard to

claim 1, Applicants submit that claim 12 is allowable for the same reasons set forth above.

Further, Applicants submit that claims 13-16 and 18 are allowable, at least because of their

dependency.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 1-6, 8-10, 12-16 and 18 under § 103(a) as being

unpatentable over Rodriguez in view of Kirkpatrick et al. (US 6,691,138). Applicants traverse

this rejection as follows.

The Examiner contends that Rodriguez teaches or suggests most of the features recited in

claim 1, but concedes that Rodriguez fails to expressly teach or suggest "a display driving unit

which displays the search window and the edit window together in a single display screen." To

compensate for this deficiency, the Examiner applies Kirkpatrick.

Applicants submit the Examiner has failed to establish *prima facie* obviousness because

even if Rodriguez and Kirkpatrick could be combined as suggested by the Examiner, the

suggested combination fails to teach or suggest all the features recited in claim 1.

Fails To Teach Or Suggest All Recited Features

Claim 1 recites, *inter alia*, "a media file management unit that creates a search window

that displays media files to be searched and an edit window that displays a media content file to

be edited;" and

"a display driving unit that displays the search window and the edit window together in a

single display screen."

The Examiner contends that Kirkpatrick teaches a display that displays a search window

and an edit window together in a single display screen. In particular, the Examiner contends that

the display of FIG. 4A teaches this feature. Kirkpatrick teaches that FIG. 4A is an exemplary

search window 402 which preferably contains a text edit windows 404, 406 and 408, for

inputting text used for searching. (*See* FIG. 4A, col. 6, lines 19-35). Accordingly, Kirkpatrick

<u>merely teaches of an edit window for inputting text for searching</u>. Thus, Kirkpatrick, like

Rodriguez, merely teaches of adding a text edit window into a search window for inputting text

for which to search.

As discussed above, Rodriguez, itself, only discloses a text edit window. Therefore, even

if combined as attempted by the Examiner, the applied combination of Rodriguez and

Kirkpatrick only teach or suggest displaying a text edit window within a search window.

Therefore, the applied combination fails to teach or suggest any "edit window that displays <u>a</u>

<u>media content file to be edited</u>" and "a display driving unit that displays the search window and

the edit window together in a single display screen," as recited in claim 1.

Thus, Applicants submit that claim 1 is allowable for at least this reason. Additionally,

Applicants submit that claims 2-6 and 8-10 are allowable, at least because of their dependency.

Because claim 12 recites features similar to those set forth above with regard to claim 1,

Applicants submit that claim 12 is allowable for the same reasons set forth above. Further,

Applicants submit that claims 13-16 and 18 are allowable, at least because of their dependency.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 7, 11, 17, 19 and 20 under § 103(a) as being unpatentable

over Rodriguez in view of Kirkpatrick as applied to claims 1-6, 8-10, 12-16 and 18 and in further

view of Fernandez.

Applicants submit that because both of these references are deficient for at least the same reasons as set forth in our proposed arguments above, that neither Rodriguez, Kirkpatrick, nor Fernandez, either alone or in combination, teach or suggest, at least the features recited in independent claims 1, 12 and 20, namely, "a media file management unit that creates a search window that displays media files to be searched and an edit window that displays a media content file to be edited;" and

"a display driving unit that displays the search window and the edit window together in a single display screen.

Thus, Applicants submit that claim 20 is allowable for at least this reason. Additionally, Applicants submit that claims 7, 11, 17 and 19 are allowable, at least because of their dependency.

New Claims

New claims 21 and 22 are added by this Amendment and submitted to be allowable, at least because of their dependency from claim 12. Additionally, claim 21 is supported, at least by FIG. 4 of the present specification. Claim 22 is supported, at least, by S30 of FIG. 5.
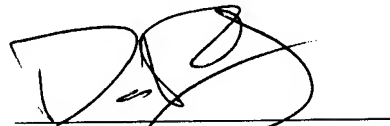
Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No. 10/647,300

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The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

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